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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,441	09/18/2003	Earl O. Bergersen	BER-P-03-054	7298
29013	7590	12/28/2007		
PATENTS+TMS, P.C. 2849 W. ARMITAGE AVE. CHICAGO, IL 60647			EXAMINER LEWIS, RALPH A	
			ART UNIT 3732	PAPER NUMBER
			MAIL DATE 12/28/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/665,441	Applicant(s) BERGERSEN, EARL O.	
	Examiner Ralph A. Lewis	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-87 is/are pending in the application.
- 4a) Of the above claim(s) 21-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 35-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Election by Original Presentation

Newly amended claims 21-34 are directed to an invention that is independent or distinct from the invention originally claimed because they are directed to a method of sequentially using different sized appliances to treat a patient whereas the remaining claims are directed to particular embodiments of an appliance. The method could be performed by appliances other than the embodiments claimed and the embodiments claimed can be used in methods other than a sequential method where different sized appliances are used on a patient over time.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-34 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Obvious-Type Double Patenting Rejections

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 and 35-87 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over

Claims 1-110 of copending Application No. 10/447,099;

Claims 1-114 of copending Application No. 10/449,292;

Claims 1-139 of copending Application No. 10/449,312;

Claims 1-82 of copending Application No. 10/760,604; and

Claims 1-51 of copending Application No. 11/257,330

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are merely obvious variations of the claims presented in applicant's other applications. Merely rearranging the order of claimed elements and using different wording to refer to the same subject matter would have been obvious to the ordinarily skilled artisan.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-6, 8-12, 14, 16, 17, 19, 20, 35-39, 44-51, 58-66 and 68-87 are rejected under 35 U.S.C. 102(b) as being anticipated by Bergersen (US 5,645,420).

Bergersen '420 discloses a dental appliance having a general U-shaped base (Figure 2), flat occlusal surface 50 (note Fig 5), first wall 26, second wall 28, slot 22 whose width increases from the front (Figure 3) to the rear (Figure 5). In regard to the newly added limitation of claim 1 that there is a wire embedded in the base and extending vertically from the base along one side of a tooth, applicant's attention is drawn to Figures 13 and 14 of Bergersen '420 where such a feature is clearly shown. In regard to claim 4, note lingual tabs 34. In regard to claim 6, note column 8, lines 1-22. In regard to claim 8, note wedges 22 (Figure 3). In regard to claim 9, note Fig 15. In regard to claims 35 and 39, note column 11, lines 5-12, regarding the delivery of fluoride. Additionally, in regard to claims 41 and 42, Bergersen '420 discloses a second portion 60 of the device which is made of a softer material and which contacts a second set of teeth which is different from the first set of teeth which are not contacted by the softer material 60. In regard to claims 35 and 39, note column 11, lines 5-12, regarding the delivery of fluoride.

In response to the rejection of claim 1, applicant added the further limitation that the dental appliance has a wire embedded in the base that extends vertically from the base adjacent only one side of a tooth. Applicant's earlier '420 patent has an embedded wire 104 to "assist in maintaining the desired buccal expansion dimension or other configuration of the appliance" (column 10, lines 4-10) that in Figures 13 and 14 is clearly illustrated as extending vertically adjacent one side of a tooth.

In response to the rejection of claims 35 and 39, applicant further added the limitation regarding the addition of fluoride to the device which was also clearly disclosed in applicant's earlier patent ten years ago.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7, 13, 43, 52-57 and 85-87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergersen (US 5,645,420).

In regard to claims 7, 18, Bergersen discloses the wire 104 embedded in an external wall rather than the internal wall as claimed. One of ordinary skill in the art, however, would have found it obvious to have embedded the wire in the internal wall of the appliance in order to push the inner side of the patient's teeth. In regard to claim 13,

constructing the appliance so that it does not touch the occlusal surface of every tooth (e.g. a tooth that is not fully erupted) would have been obvious as a matter of routine practice. In regard to claim 43, the inclusion of a conventional slit in the Bergersen appliance in order to increase flexibility would have been obvious to one of ordinary skill in the art. In regard to claim 52-57, it would have been obvious for the practitioner to explain to the patient using convention methods what procedure was being under taken.

Claims 15, 40 and 67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergersen (US 5,645,420) in view of Andrews (US 4,591,341).

Andrews teaches the use of small suction cups (14, 16, 20, 24, 26, 30) positioned in an orthodontic appliance in order to provide increased adherence and firmly hold the teeth together in the desired position. To have provided the Bergersen orthodontic appliance with small suction cups in order to provide increased adherence and firmly hold the teeth together in the desired position as taught by Andrews would have been obvious to one of ordinary skill in the art.

Claims 6, 42 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergersen (US 5,645,420) in view of Watson et al (US 5,328,362).

Watson et al teach the construction of dental appliances of a first relatively rigid material and a second relatively soft resilient material for aiding in the proper movement of the patient's teeth. To have constructed the Bergersen orthodontic appliance of hard

and soft materials as taught by Watson et al in order to aid in the proper movement of the patient's teeth would have been obvious to one of ordinary skill in the art.

Action Made Final

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number:
10/665,441
Art Unit: 3732

Page 8

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Cris Rodriguez, can be reached at (571) 272-4964.

R.Lewis
December 26, 2007

/Ralph Lewis/
Primary Examiner
Art Unit 3732